

REMARKS

Applicant respectfully requests reconsideration. Claims 1-9 were previously pending in this application. Claims 1-9 have been amended. Claims 10 and 11 have been added. As a result, claims 1-11 are pending for examination, with claims 1-3 being independent claims. No new matter has been added.

In view of the above amendment, applicant believes the pending application is in condition for allowance.

Rejections under 35 U.S.C. §112

The Examiner rejected claims 1-9 under 35 U.S.C. §112, paragraph for failing to comply with the enablement requirement. The claims have been amended to recite concrete steps that may be performed either by a person or a machine as part of a method of determining motivation. In rewording the claims, many of the phrases found objectionable by the Examiner have been removed. To the extent any of the objectionable phrases remain, Applicant contends that those phrases are expressed as concrete steps that one of skill in the art of investigating marketplace motivation or consumer interest would know how to perform.

Claims 5 and 8 are rejected under 35 U.S.C. §112, paragraph 2 for being indefinite. Claims 5 and 8 have been amended to resolve the lack of antecedent basis noted by the Examiner.

Accordingly, withdrawal of the rejection of claims 1-9 under 35 U.S.C. §112 is respectfully requested.

Rejections under 35 U.S.C. §101

The Examiner rejected claims 1-9 under 35 U.S.C. §101 for not creating a useful, concrete and tangible result. This rejection is premised on the Examiner's assertion that the claimed method is not reproducible because it is based on subjective inputs. The claims have been amended to recite concrete steps performed in a process of determining motivation.

If these amendments do not overcome the rejection, Applicant contends that the Examiner has applied an incorrect standard in requiring that a process output predictable results in order to be statutory subject matter. The utility of the claimed method is to produce, in a concrete and tangible way, an indication of consumer or marketplace interest in an item. The fact that one would not be

able to predict this interest until the method is performed demonstrates the value of the method—rather than negating its patentability.

In this regard, the claimed method is no different than a multitude of other methods in which the output is influenced by variations in the inputs or conditions under which the process is performed. For example, the output of a chemical process may depend on the purity of the reagents used in the process. As another example, the output of a mining process may depend on the type of ore present at the site where the process is performed. This type of variation makes the output of the process unpredictable, but does not render such processes unpatentable.

The present claims are directly analogous to such patentable examples and should not be rejected under 35 U.S.C. §101. Though the output of the process may depend on variable factors, such as the subjective beliefs of the people in the selected group, the claims recite concrete steps taken to collect and process this variable information to produce a useful result. The claims as a whole recite a method that is useful, concrete and tangible and therefore recite statutory subject matter.

Accordingly, withdrawal of the rejection of claims 1-9 under 35 U.S.C. §101 is respectfully requested.

Rejections under 35 U.S.C. §102

The Examiner rejected claims 1-9 under 35 U.S.C. §102 based on a paper by Mick et al. Applicants respectfully disagree that Mick discloses or suggests the method claimed in the present application.

Mick describes a study in which motivations and meanings of self-gifts were explored. In the study, a thematic apperception test was employed. Consumers were asked to create stories from pictures illustrating a scene about which information was desired. In contrast to the disclosure in the present application, the reference does not relate to facilitating group interaction. In Mick, information was obtained from consumers individually (see page 2, last paragraph). Furthermore, it appears that the stories were analyzed by researchers and not a group representative of consumers (see page 4, second to last paragraph).

Accordingly, the Mick reference does not teach or suggest multiple limitations of each of the independent claims. For example, there is no teaching or suggesting of “conducting one or more

discovery sessions with the group.” Also, the reference does not teach or suggest “collecting from the group possible meanings of the portions of the responses in the first database.” Similarly, there is no teaching or suggestion of “forming a first set of subgroups” or “forming a second set of subgroups.”

As to claim 2, the reference does not teach or suggest limitations such as “obtaining from a representative group of consumers of group information” or “obtaining from the group possible derived meanings” or “obtaining from a first portion of the group ...” or “obtaining from a second portion of the group ...”

Claim 3 uses the “step for” structure expressly authorized by 35 U.S.C. §112, paragraph 6. Claim 3 expressly recites “a step for using three process theory techniques” as described in the present application. In contrast, the reference expressly describes the use of a thematic apperception test. Because the reference does not teach or suggest a step for using three process theory techniques, it cannot teach the remaining steps of the claim.

The remaining claims depend from one of claims 1, 2 or 3 and distinguish the reference for at least the same reasons given above for the corresponding independent claim. The dependent claims recite limitations that provide further reasons that the rejection should be withdrawn.

Accordingly, withdrawal of the rejection of claims 1-9 under 35 U.S.C. §102 is respectfully requested.

CONCLUSION

A Notice of Allowance is respectfully requested. The Examiner is requested to call the undersigned at the telephone number listed below if this communication does not place the case in condition for allowance.

If this response is not considered timely filed and if a request for an extension of time is otherwise absent, Applicant hereby requests any necessary extension of time. If there is a fee occasioned by this response, including an extension fee, that is not covered by an enclosed check, please charge any deficiency to Deposit Account No. 23/2825.

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Respectfully submitted,

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